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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LONNIE WARD III

Appeal 2017-010796
Application 14/662,118
Technology Center 3700

Before JENNIFER D. BAHR, MICHELLE R. OSINSKI, and
BRANDON J. WARNER, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Lonnie Ward III (“Appellant”), proceeding *pro se*, appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–5, which are all the pending claims. *See* Appeal Br. 1.¹ We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Reference herein is made to Appellant’s Amended Appeal Brief (“Appeal Br.”), filed March 8, 2017.

CLAIMED SUBJECT MATTER

Appellant's disclosed invention relates to "an improving game competition system." Spec. 1.² Claims 1 and 5 are independent. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of operating a martial art competition system having a plurality of scoring methods, sub[-]systems for the compensation and advancement of martial artist, said method comprising the steps of: determining by challenge the ability and performance of one or more martial artist of said method.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

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| Sedq | US 2013/0005419 A1 | Jan. 3, 2013 |
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REJECTIONS

The following rejections are before us for review:

- I. Claims 1–5 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2–3.
- II. Claims 1–5 stand rejected under 35 U.S.C. § 102(a)(1) as anticipated by Sedq. *Id.* at 4–7.

² We note that the Specification in the present application lacks page numbers. For reference convenience, we designate the page with the heading "SPECIFICATION" as page 1 and number the pages consecutively therefrom.

ANALYSIS

Rejection I— Claims 1–5 as directed to patent-ineligible subject matter

A patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has consistently held that this provision contains an important implicit exception: laws of nature, natural phenomena, and abstract ideas are not patentable. *See Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”).

Notwithstanding that a law of nature or an abstract idea, by itself, is not patentable, an application of these concepts may be deserving of patent protection. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293–94 (2012). In *Mayo*, the Court stated that “to transform an unpatentable law of nature into a patent-eligible *application* of such a law, one must do more than simply state the law of nature while adding the words ‘apply it.’” *Mayo*, 132 S. Ct. at 1294 (citation omitted).

In *Alice*, the Court reaffirmed the framework set forth previously in *Mayo* “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are directed to a patent-ineligible concept, then the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to

determine whether there are additional elements that “transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297).

In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent on the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant postsolution activity.” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation and internal quotation marks omitted). The Court in *Alice* noted that “[s]imply appending conventional steps, specified at a high level of generality,” was not “enough” [in *Mayo*] to supply an “inventive concept.” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 132 S. Ct. at 1300, 1297, 1294).

In rejecting claims 1–5 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter, the Examiner determined that “the claim(s) as a whole, considering all claim elements both individually and in combination, do not amount to significantly more than an abstract idea.” Final Act. 2–3. In particular, the Examiner determined that the claims “are directed to the abstract idea of rules for scoring methods to advance through a tournament,” and “the additional claim elements (*i.e.* a method of operating a martial art competition system) are merely conventional and do not add any improvement so that these elements do not significantly add to the abstract idea/rules.” *Id.* at 3. The Examiner explains that the steps recited in independent claims 1 and 5 “are directed to rules governing an

activity (a martial art competition),” where “[m]ethods of managing a game have been found to be abstract ideas (See: *Planet Bingo, LLC v. VKGS LLC*, 576 Fed. Appx. 1005 (Fed. Cir. 2014))[,] and a set of rules for a game have been found to be abstract ideas (See: *In Re Smith*[, 815 F.3d 816] (Fed. Cir. 2016)).” Ans. 7 (italics added).

Appellant argues that “the current invention is directed to patent eligible subject matter considering all relevant factors with respect to the [c]laim(s) and [c]laimed invention as a whole.” Appeal Br. 5. Appellant asserts that the claims contain an inventive concept sufficient to transform the abstract idea into a patent-eligible application. *See id.* For the reasons discussed below, we are not persuaded by Appellant’s arguments.

Step one:

In the first step of the *Alice* analysis, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016), *cert. denied*, 138 S. Ct. 469 (2017) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)).

Independent claim 1 recites “[a] method of operating a martial art competition system having a plurality of scoring methods, sub[-]systems for the compensation and advancement of martial artist, said method comprising the steps of: determining by challenge the ability and performance of one or more martial artist of said method.” Appeal Br. 17 (Claims App.).

Independent claim 5 similarly recites “[a] method of operating a martial art competition system having a plurality of scoring methods, sub[-]systems for

the compensation and advancement of martial artist, said method comprising the steps of: awarding compensation and/or granting approval for the advancement to professional of martial artist, including competition system results.” *Id.* Appellant’s Specification describes “an improving game competition system.” Spec. 1. In particular, the Specification describes that

[a] well-known game utilizing the hand and foot is Tae Kwon Do. In the game of Tae Kwon Do, two or more participants compete on a mat for two or three rounds that last two minutes per round, the object is to score as many points as possible by landing kicks to the torso, head and punches only to the chest, in a given time to be called a winner. This game requires skill, balance, coordination, stamina and agility.

Id. According to the Specification, “[a]n advantage of the present invention include[s,] without limitation, an opportunity to solve a specific problem by building a community for which the advanced amateur athlete can compete in on the professional level while playing a Martial Art game as in Tae [K]won [D]o.” *Id.* at 4.

Here, we agree with the Examiner that Appellant’s claims “are directed to rules governing an activity (a martial art competition).” Ans. 7. In particular, the claims are directed to an abstract idea of organizing human activities similar to the method of managing a game at issue in *Planet Bingo* and the set of rules for a game at issue in *In re Smith*. See *Planet Bingo*, 576 Fed. App’x at 1008 (citing *Alice*, 134 S. Ct. at 2356) (the court stating that the claims were “similar to the kind of ‘organizing human activity’ at issue in *Alice*”); see also *In re Smith*, 815 F.3d at 819 (“the rejected claims, describing a set of rules for a game, are drawn to an abstract idea”) (emphasis added); *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (“we have applied the ‘abstract idea’ exception to

encompass inventions pertaining to methods of organizing human activity”) (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015)). In this regard, Appellant does not apprise us of a meaningful distinction in the form or type of the claims between those presently recited and those previously adjudicated in *Planet Bingo* and *In re Smith*.

Step two:

As to the second step of the *Alice* analysis, we agree with the Examiner’s determination that the elements of independent claims 1 and 5, and their dependent claims, individually or as an ordered combination, do not amount to significantly more than the abstract idea. *See* Final Act. 3; Ans. 7. We not persuaded by the Appellant’s arguments to the contrary. *See* Appeal Br. 4–7, 15–16.

In particular, Appellant argues that the claimed methods provide a financial reward for competition winners, which represents a concrete and tangible result. *See id.* at 6; *see also id.* at 7 (asserting that “the current invention clearly defines compensation as being Rewarded Financially, and the compensated as Tangible, result or results” (citing Spec. 4, ll. 6–9)). However, regardless of whether the claimed methods encompass providing concrete or tangible financial compensation, “[i]t is well-settled that mere recitation of concrete, tangible components is insufficient to confer patent eligibility to an otherwise abstract idea.” *TLI*, 823 F.3d at 613.

Given the binding precedent of our reviewing courts, we agree with the Examiner’s ultimate conclusion that the present claims are directed to patent-ineligible subject matter, particularly in light of the explanation

provided at pages 2–3 of the Final Action and pages 6–7 of the Examiner’s Answer.

In short, we find nothing in claims 1–5 to be sufficiently transformative to render the claims patent eligible. For these reasons, we affirm the Examiner’s rejection of claims 1–5 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Rejection II – Claims 1–5 as anticipated by Sediq

In rejecting independent claim 1, the Examiner found that

Sediq (Figures 1–5) teaches a method of operating a martial art competition system (See figures 3–4) having a plurality of scoring methods (Page 2, Para. 0023, Lines 1–15), sub[-]systems for the compensation and advancement of martial artist, said method comprising the steps of: determining by challenge the ability and performance of one or more martial artist of said method (Page 2, Para. 0024, Lines 1–14) (Page 2, Para. 0026, Lines 1–15).

Final Act. 4.

Appellant contests the rejection by reproducing the Examiner’s findings articulated in the rejection, describing the corresponding disclosure in the cited portions of Sediq, and describing relevant disclosure in Appellant’s Specification. *See* Appeal Br. 7–8, 13–14 (citing Spec. 4). Appellant asserts that he “disagrees” with the Examiner’s findings (*id.* at 8, 12–14), but does not provide factual evidence or persuasive technical reasoning to identify error in the Examiner’s findings as to the disclosure of Sediq. In other words, Appellant does not persuasively explain why the cited portions of Sediq would be insufficient to support the Examiner’s findings.

Appellant further asserts that “Sediq describes repetitive use of a scoring method” (*id.* at 8 (citing Sediq, Figs. 3–4)), whereas the “[c]laimed invention describes repetitive use of multiple scoring methods” (*id.* (citing Spec. 4)). According to Appellant, the claimed invention is “[n]ot comparable to Sediq.” *Id.* This argument is unpersuasive because it is not commensurate with the scope of claim 1. As stated by our reviewing court in *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998), “the name of the game is the claim.” It is well established that limitations not appearing in the claim cannot be relied upon for patentability. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Here, claim 1 only recites a single step of “determining by challenge the ability and performance of one or more martial artist of said method.” Appeal Br. 17 (Claims App.). Although the preamble of claim 1 recites “[a] method of operating a martial art competition system having a plurality of scoring methods,” the only operative step recited in the body of the claim does not require repetitive use of multiple scoring methods. *Id.* Moreover, Appellant’s assertion that Sediq is “not comparable” (*see id.* at 8) does not persuasively distinguish claim 1 from the disclosure of Sediq.

Regarding dependent claims 2–4 and independent claim 5, although Appellant addresses these claims under separate headings (*see id.* at 9–11), Appellant’s arguments are unconvincing for the same reasons discussed above with respect to independent claim 1. Namely, Appellant merely reproduces portions of the Examiner’s rejection, Sediq, and the Specification without persuasively explaining why the Examiner’s specific findings as to the disclosure of Sediq would be deficient. *See* Final Act. 7.

For the above reasons, Appellant does not apprise us of error in the Examiner's finding that Sediq anticipates the subject matter of claims 1–5. Accordingly, we sustain the rejection of claims 1–5 under 35 U.S.C. § 102(a)(1) as anticipated by Sediq.

DECISION

We AFFIRM the Examiner's decision rejecting claims 1–5 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

We AFFIRM the Examiner's decision rejecting claims 1–5 under 35 U.S.C. § 102(a)(1) as anticipated by Sediq.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED